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10/563,394

04/05/2006

Harald Schneider

3588

1514

278

7590

06/27/2008

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EXAMINER

BOCHNA, DAVID

ART UNIT

PAPER NUMBER

3679

MAIL DATE

DELIVERY MODE

06/27/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/563,394 | Applicant(s) SCHNEIDER ET AL. | |
| | Examiner David E. Bochna | Art Unit 3679 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 15-18 is/are rejected.
- 7) ☒ Claim(s) 7-14 and 19-31 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because the inventors have not dated the declaration.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Objections

2. Claims 7-14 and 19-31 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. Also all multiple dependent claims must refer to prior claims in the alternative. For example the phrase "one of claims 1 to 8" is an improper multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.
3. Claims 1-6 and 15-18 are objected to because of the following informalities:
"characterised" should be changed to "characterized". Appropriate correction is required.
4. Claim 16, it is unclear to which component the word "it" is referring.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Day '100.

In regard to claim 1, Day discloses a screw connection element 1 having an outer threaded portion 4 and a sealing means 5 which is disposed in the threads 4 thereof, characterized in that it is provided with a protective covering 6 which surrounds the outer threaded portion 4, is produced from a flexible material (wax) and is intended for retaining the sealing means 5 in the threads 4.

In regard to claim 2, characterized in that the protective covering 6 is applied on the outer threaded portion by an immersion process.

7. Claims 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Vincent '743.

In regard to claim 15, Vincent discloses a protective covering 14 for a screw connection element which is provided with an outer threaded portion which is intended for receiving a sealing means 32, comprising a sheath 14 which is intended for screwing onto the outer threaded portion.

In regard to claim 16, characterized in that it 14 has an inner diameter which corresponds essentially to the outer diameter of the outer threaded portion 10.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronfeldt '478 in view of Vincent '743.

In regard to claim 1, Ronfeldt discloses a screw connection element 11 having an outer threaded portion, characterized in that it is provided with a protective covering 21 which surrounds the outer threaded portion, is produced from a flexible material (sheet metal) that is intended to create a thread protector that protects the threads from corrosion and seals the threads from coming in contact from the outside elements, but Ronfeldt does not disclose the use of a sealing means being placed in between the threads. Vincent '743 teaches the use of a sealing means 32 in combination with a protective covering 14 in order to improve upon the sealing properties of the thread protector. Therefore it would have been obvious to one of ordinary skill

in the art to modify the thread protector of Ronfeldt '478 to use a sealing means in combination with a sheath, as taught by Vincent, in order to better seal out corrosive elements and improve upon the sealing properties of the thread protector.

In regard to claim 3, characterized in that the protective covering (10) comprises a sheath which is produced by deep-drawing (this is a product by process limitation and carries little patentable weight in an apparatus claim, as long as the product of the applied prior contains the same structural limitations of the present invention, it is deemed to anticipate the claim) and screwed onto the outer threaded portion (6).

In regard to claim 4, characterized in that the protective covering 21 is provided on its rear side with a mounting flange 16.

In regard to claim 5, characterized in that the mounting flange 16 abuts on a shoulder 13 which is provided on the rear end of the outer threaded portion and can be connected to said shoulder 13.

In regard to claim 6, characterized in that the mounting flange 16 can be bonded to the shoulder by gluing (the flange 16 is capable of being glued to 13 even though Ronfeldt may not disclose that connection step).

10. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over EPO 242,796.

In regard to claim 15, The EPO patent discloses (fig. 4) a protective covering 5,9 for a screw connection element which is intended for receiving a sealing means 13, comprising a sheath 11 which is intended for screwing onto a threaded portion 4. The EPO patent discloses the sheath as having exterior threads for mating with the internal threads of a pipe instead of

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internal threads for mating with exterior threads of a male pipe, as recited by the applicant.

However, it would have been obvious to one of ordinary skill in the art to modify the connection of the EPO patent to include internal threads on the sheath for accepting a male threaded pipe end because the reversal of components in a prior art reference, where there is no disclosed significance to such reversal, is a design consideration within the skill of the art. In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955); In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

In regard to claim 16, characterized in that it 5,9 has an inner diameter which corresponds essentially to the outer diameter of the outer threaded portion 2.

In regard to claim 17, characterized in that it contains an inner part (inner bore of 5,9) with an inner wall which is adapted to the outer threaded portion 2 and an outer part 11 which surrounds the inner part (20) and is provided with a sealing means 13 between the inner and outer part.

In regard to claim 18, characterized in that the inner (inner sleeve defining the inner bore of 5,9) and the outer part (11) can be connected to each other securely (they must be securely connected in order to form a void for sealing agent 13).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sakamoto, Stevenson et al., Terrizzi, Fraering, Wallace '712, Wallace '982, Lang et al., Squires, Weber, Lock et al., Pearce, Anthony, Philips, Elmer, Unke, Krause, Goldberg, Severn, Hicks and Birger all disclose similar couplings common in the art.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Bochna whose telephone number is (571) 272-7078. The examiner can normally be reached on 8-5:30 Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David E. Bochna/
Primary Examiner, Art Unit 3679